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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/763,392   | 10/02/2001  | Mathew Reardon       | GRIFH-56299         | 4867             |
| 24201  | 7590        | 10/05/2004           | EXAMINER            |                  |
| FULWIDER PATTON LEE & UTECHT, LLP<br>HOWARD HUGHES CENTER<br>6060 CENTER DRIVE<br>TENTH FLOOR<br>LOS ANGELES, CA 90045 |             |                      | NGUYEN, CUONG H     |                  |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             | 3625                 |                     |                  |
| DATE MAILED: 10/05/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/763,392             | REARDON ET AL.      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | CUONG H. NGUYEN        | 3625<br><i>MW</i>   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 May 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12, 16-18 and 24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12, 16-18 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 February 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***Status of the Claims***

1. Claims 1-12, 16-18, and 24 are elected without traverse for examination (Group I); claims 13-15, 19-23 have been canceled by the applicants on 5/10/2004.

***Response***

2. The examiner respectfully submits that applicants are claiming an apparatus in above elected claims, therefore, any claiming of functional language should then be limited to an apparatus as to oppose to a process or method.

Because apparatus claims cover structures of a system. A "use" can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d 381, 384, 137 USPQ 1084, 1088 (CCPA 1963). Claims directed to a system must be distinguished from the prior art in terms of structures rather than functions. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function "even if not directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 1-5, 8-9, 16-18, 24 are rejected under 35 U.S.C.**

**102(e) as being anticipated by Smith (US Pat. 5,860,362).**

A. As to independent claims 1, 16: Smith teaches a goods requisition and supply system (see Smith, Fig.2), comprising:

- a computer system, an ordering means for generating an order, and a vending device connected to that computer and including a storage means (see Smith, 2:43-54). Smith also teaches about dispensing from printer 12 the requested "up-to-the-minute" news (see Smith, the abstract).

B. As to dependent claim 2: Smith teaches a goods requisition and supply system (see Smith, Fig.2), comprising:

- means to determine whether an ordered item is available in the storage means or is available from a remote location - Smith's system is capable to perform internal/external inventory.

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C. As to dependent claims 3, 17: Smith teaches an online goods requisition and supply system (see Smith, Fig.2), comprising:

- an ordering means to monitor stock levels of items in a vending device (see Smith, 2:33-41, Fig.2 - ref. 30 for paper sensor) to see a stock availability, and a remote supplier: NEWS PROVIDING ORGANIZATION (by external inventory - Fig.2 ref.38).

D. As to dependent claims 4, 18: Smith teaches a goods requisition and supply system (see Smith, Fig.2), comprising:

An online ordering means is resident on the computer system (see Smith Fig.2, ref. 8) and the controllable vending device (with I/O interfaces) (see Smith Fig.2, ref. 2) operates as a peripheral controlled by the computer system (see Smith Fig.2, refs. 34, 36).

E. As to dependent claim 5: Smith teaches a goods requisition and supply system (see Smith, Fig.2), comprising:

- the computer system may be a proprietary computer system, such as LAN, or Intranet (see Smith Fig.2, and 3:30-32).

F. As to dependent claim 8: Smith teaches a goods requisition and supply system (see Smith, Fig.2), comprising:

- vending device includes sensor means to sense (see Smith, Fig.2 - ref. 30).

G. As to dependent claim 9: Smith also teaches that:

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- a vending device dispenses the item on receipt of an identification means (i.e., personal info. in a credit card) from the user (see Smith 2:11-13).

H. Per independent claim 24: It is directed to a goods requisition and supply system including an input means for input data/information for approval having similar limitations of claim 9; therefore, a rejection based on 35 USC 102(e) (using Smith's reference) is also applied to claim 24.

**4. Claims 1, 7, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Vallaire (US Pat. 5,971,273).**

A. As to independent claim 1: Vallaire teaches a goods requisition and supply system, comprising:

- a computer system, an ordering means for generating an order, and a vending device connected to that computer and including a storage means (see Vallaire, the abstract).

B. As to dependent claim 7: Vallaire also teaches a vending system, comprising means for enabling remote payment for items (see Vallaire, Fig.3).

C. As to dependent claim 12: Vallaire also teaches a vending system, comprising a key pad arranged to operate in a secure mode for entering data required for remote payment and in a non-secure mode for entry of other data (see Vallaire Fig.2 - using a TOUCH SENSTIVE MONITOR as a keypad, and 4:51-58).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US Pat. 5,860,362), in view of Bernard et al. (US Pat. 5,918,213).**

The rationales and reference for rejection of claim 9 are incorporated.

Smith does not disclose of using an identification code for a transaction.

However, Bernard et al. suggest that idea, i.e. providing an identification code to a user (i.e., a customer number, or a serving number), provide the identification code to a supplier responsible for providing the vended item (i.e., submitting said customer number, or a serving number for verification)

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Smith's system with Bernard et al. to perform smoothly a transaction because using a customer id code help a lots in verifications other related information of a transaction.

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6. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US Pat. 5,860,362), in view of Krechmer et al. (US Pat. 3,634,656).**

The rationales and reference for rejection of claim 1 are incorporated.

Smith does not disclose a vending device to receive articles for recycling and the ordering means track items being placed in the vending device for recycling and advise the remote supplier.

However, Krechmer suggests about tracking goods with a counter in a vending machine (see Krechmer et al., Fig.8, ref. 761).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Smith's system with Krechmer's counter to receive articles for recycling and the ordering means track items being placed in a vending device for recycling and advise the remote supplier because the combination of a paper sensor 30 of Smith vending machine and a counter in Krechmer vending machine would provide a better degree of accuracy of recycling goods (as a feedback signal) to a remote supplier.

#### ***Conclusion***

7. Claims 1-12, 16-18, and 24 are not patentable.

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8. The attached prior art are pertinent to claimed subject matter of this pending application.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

*Cuonghnguyen*

*CHN*

CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3625